



PATENT
P56936

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SUNG-WON BAE, et al.

Serial No.: 10/644,014

Examiner: ZIMMERMAN, GLENN

Filed: 20 August 2003

Art Unit: 2879

For: PASSIVE APPARATUS THAT REGULATES A FLOW OF HEATED AIR
WITHIN A PLASMA DISPLAY DEVICE

PETITION UNDER 37 C.F.R. §1.181

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant petitions the incompleteness of the June 14, 2005 Office action (Paper No. 0605).

Folio: P56936
Date: 8/15/05
I.D.: REB/ML/fw

STATEMENT OF FACTS

1. On August 20, 2003, Applicant filed the present patent application in the U.S. Patent Office. On page 2 of Applicant's originally filed specification, Applicant cited the prior art references of JP-2001-83888 to Sakurai and JP-2001-282114 to Tsuruki.
2. On June 14, 2005, some two years later, a first Office action was mailed (Paper No. 0605). In Paper No. 0605, the Examiner stated his refusal to consider JP-2001-83888 to Sakurai and JP-2001-282114 to Tsuruki because they were not also put on an IDS form 1449 citing MPEP 609 as justification.

ARGUMENT AND/OR REMARKS

Applicant hereby petitions under 37 CFR §1.181 the incompleteness of the June 14, 2005 Office action (Paper No. 0605). Applicant submits that 37 C.F.R. 1.104 (b) has not been honored in the June 14, 2005 Office action (Paper No.0605) because the Examiner refused to consider clearly cited JP-2001-83888 to Sakurai and JP-2001-282114 to Tsuruki.

Applicant submits that the Examiner improperly questioned Applicant's discussion pursuant to 37 CFR §1.71(a)and(b) on page 2 of the specification. Correction is required and expungement of any statement which would imply a less than thorough and complete examination of the pending application.

Moreover, the Examiner improperly interpreted section 609 of the *Manual Of Patent Examining Procedure*, revision 2 (May 2004) which states:

“The list of information complying with the identification requirements of 37 CFR §1.9 (a)(b) may not be incorporated into the specification of the Application in which it is being supplied, but must be submitted in a separate sheet of paper.”

In the instant application, part is Applicant's submission of an Information Disclosure Statement in response to the Examiner's request set forth in Paper Number 0605, the instant

application contained no “ list of information” submitted under 37 CFR §1.98 (b). Consequently, Applicant submits that §609 of the Manual is not applicable to this application. Rather, the instant application contained a discussion of the art written “in such a manner as to distinguish it from other inventions and from what is old” as is required under 37 CFR §1.71(a) and (b), and to “particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates ...” and “to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it” as is required under 37 CFR §1.71(c). Consequently, to the extent that Applicant’s originally filed specification and information incorporated into or otherwise referred to by that specification have not been considered prior to the mailing of Paper Number 0605, Paper Number 0605 is incomplete under 37 CFR §1.104(a)(b)(c). Clarification is requested and a corrected and fully complete first Office Action in substitution of the incomplete Office Action represented by Paper Number 0605 is respectfully requested.

In addition Applicant submits that the Examiner’s obstructionistic behavior violates the notions of compact prosecution, customer service and notions of fairness, especially when the Examiner fails to consider prior art references clearly and unmistakably brought to his attention by the Applicant in an attempt to comply with his duty of candor under 37 C.F.R. 1.56.

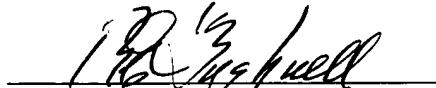
Even though Applicant did later on July 8, 2005 file an IDS listing JP-2001-83888 to Sakurai and JP-2001-282114 to Tsuruki, Applicant submits that the June 14, 2005 Office action was entirely inadequate and incomplete under 37 C.F.R. 1.,104 and must be vacated in place of a new, complete Office action. Further, the Applicant submits that the Examiner's statements regarding this matter on pages 2 and 3 of the June 14, 2005 Office action needs to be expunged from the prosecution history.

RELIEF REQUESTED

Therefore, in view of the foregoing, the Commissioner is respectfully requested to:

- A. Vacate the June 14, 2005 Office action (Paper No. 0605);
- B. Issue a new and complete Office action considering cited JP-2001-83888 to Sakurai and JP-2001-282114 to Tsuruki;
- C. Expunge Examiner's statement on Pages 2 and 3 of the June 14, 2005 Office action regarding the IDS from the prosecution history; and
- D. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56936
Date: 8/15/05
I.D.: REB/ML